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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,716	07/18/2000	Kyoji Saito	P19789	9554
7055	7590	12/01/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LIN, KENNY S	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/618,716

Applicant(s)

SAITO, KYOJI

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30, 31, 35 and 36 is/are allowed.
- 6) ☒ Claim(s) 13-29 and 32-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 13-36 are presented for examination.

***Allowable Subject Matter***

2. Claims 30-31 and 35-36 are allowed. Reason of allowance can be found in the previous office action.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 1 19(a)-(d), which papers have been placed of record in the file.
4. The effective filing date for the subject matter defined in the pending claims which have support in parent JP 11-321411 in this application is 11/11/1999. Any new subject matter defined in the claims not previously disclosed in parent JP 11-32141 1, is entitled to the effective filing date of 07/18/2000.
5. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 1 19(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

***Claim Rejections - 35 USC § 103***

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al (Toyoda), US 5,812,278, in view of RFC2305 - "A Simple Mode of Facsimile Using Internet MAIL" (RFC2305) published in March 1998.

8. As per claim 13, Toyoda taught the invention substantially as claimed including an image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network (col.3, lines 20-23); and a controller configured to convert the attached data into image data; the controller further being configured to judge whether or not the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus based on whether or not a header of the received e-mail includes a predetermined character string (col.6, lines 38-46, lines 57-61, col.7, lines 52-63).

9. Toyoda did not expressly teach the predetermined character string being related to a sender of the error mail. Toyoda suggested exploration of art and/or provided a reason to modify the image apparatus with the predetermined character string being related to a sender of the error mail (col.6, lines 57-61, col.7, lines 52-63). RFC 2305 disclosed teachings of judging the received e-mail based on whether or not a header of the e-mail includes a predetermined

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character string, the predetermined character string being related to a sender of the error mail (Sections 2.2.1, 5.1, 5.2.1, 5.2.2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image receiving apparatus of Toyoda with the teachings of RFC 2305 to include the sender judging feature in order to maintain interoperability with Internet mail (Section 5.1) since any security to be provide should be part of the Internet security infrastructure (Section 5.1). In addition, parsing the sender to determine the mail status would also help save resources since unnecessary processing or error or failure mails consume resources and therefore undesirable (Section 5.2.2 paragraphs 1-2).

10. As per claim 14, Toyoda and RFC 2305 taught the invention substantially as claimed in claim 13. Toyoda further taught the image receiving apparatus further comprise a printer configured to print the image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (col.1, lines 43-61, col.19, lines 24-50, col.20, lines 3-52).

11. As per claim 15, Toyoda and RFC 2305 taught the invention substantially as claimed in claim 13. Toyoda further taught the image receiving apparatus to further comprise a printer configured to print image data, where in the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted image data (col.1, lines 43-61, col.19, lines 24-50, 57-61, col.20, lines 3-52).

12. As per claims 20-22, the method corresponds directly to the image receiving apparatus of claims 13-15, and thus these claims are rejected with the same rationale.

13. Claims 16-19, 23-27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al (Toyoda), US 5,812,278, in view of Praitis et al (Praitis), US 6,594,697 and Mori, US 6,417,930.

14. As per claims 16, Toyoda taught the invention substantially as claimed including an image receiving apparatus receiving an e-mail, the e-mail including a header and a body, the body including a message, the message including an image data part (figs. 6-7), the image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network (col.3, lines 20-23); and a controller configured to convert the attached data to image data (col.1, lines 42-61); and the controller further being configured to search for a predetermined information, and to judge that the received e-mail is an error mail being related to an e-mail transmitted by the image receiving apparatus, the error mail being related to an e-mail transmitted by the image receiving apparatus, when the predetermined information is detected (col.6, lines 38-46, 57-61, col.7, lines 52-63).

15. Toyoda did not expressly teach for a predetermined image data fixed code in the image data part of the e-mail of the body of e-mail and to judge that the received e-mail is an error mail when the predetermined image data fixed code is detected. Toyoda suggested exploration of art

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and/or provided a reason to modify the image receiving apparatus with the searching of signature code in a multi-part mail structure (fig.7, col.13, lines 20-25, col.2, lines 5-11). Praitis taught a controller for searching a predetermined data code in the data part of the electronic message and to judge that the received message is an error message, the electronic message being related to a message request transmitted by the receiving apparatus, when the predetermined data code is detected (abstract, figs. 2-3, 5-7, col.9, lines 10-22, 34-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Toyoda with the teachings of Praitis to include the searching of data code in an electronic message structure in order to provide a more efficient method of identify the related error since the server often create a returned message response having error information in the header and in the body of the message (Praitis, col.9, lines 18-22). Toyoda and Praitis did not expressly teach a multi/part structure electronic message having a predetermined data fixed code. Mori taught a network facsimile apparatus having a receiver configured to receive e-mails and a controller for searching a predetermined image data fixed code [boundary code] in the image data part of the e-mail when the receiving e-mail is a multi-part structure (figs. 5, 7 10AA, col.11, lines 25-34, col.13, lines 40-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined apparatus of Toyoda and Praitis with the teachings of Mori to include the searching of image data fixed code in a multi-part mail structure in order to provide a more accurate method of identified error mail since header information are trivial to fake or unavailable and image data fixed code is often present in multi-part mail structure (Mori, figs. 5, 7).

16. As per claim 17, Toyoda, Praitis and Mori taught the invention substantially as claimed in claim 16. Mori further taught the controller to search for the predetermined image data fixed code in the whole received e-mail when the received e-mail is a single-part structure, and judges that the received e-mail when the received e-mail is a single-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected (fig. 7, col.11, lines 25-34, col.13, lines 40-57).

17. As per claim 18, Toyoda, Praitis and Mori taught the invention substantially as claimed in claim 17. Toyoda further taught a printer configured to printer image data, wherein the controller, when a error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (col.1, lines 43-61, col.19, lines 24-50, col.20, lines 3-52).

18. As per claim 19, Toyoda, Praitis and Mori taught the invention substantially as claimed in claim 17. Toyoda further taught a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted predetermined image data (col.1, lines 43-61, col.19, lines 24-50, lines 57-61, col.20, lines 3-52).

19. As per claim 23-26, the method corresponds directly to the image receiving apparatus of claims 16-19, and thus these claims are rejected under the same rationale.



20. As per claim 27, the apparatus corresponds to the image receiving method of claim 23, and thus is rejected under the same rationale. Toyoda, Praitis and Mori taught the invention substantially as claimed including an image communication apparatus connected to a server and receiving an e-mail, when the received e-mail is an error mail, the e-mail including a header and a body, the body including a message, the message including an image data part (Toyoda, figs. 6-7, col.13, lines 20-25), the image communication apparatus comprising: a receiver configured to receive an e-mail to which data is attached, via the server; a converter configured to convert the attached data into image data (Toyoda, col.1, lines 42-61); a memory configured to store a predetermined image data fixed code, an image data fixed code being contained in the image data part (Toyoda, col.1, lines 42-61, col.7, lines 52-63; Praitis, abstract, figs. 2-3, 5-7, col.9, lines 10-22, 34-51; Mori, figs. 5, 7, 10AA, col.11, lines 25-34, col.13, lines 40-57); and a controller configured to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of the received e-mail, and to judge that the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus, when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory (Toyoda, col.6, lines 38-46, 57-61, col.7, lines 52-63; Praitis, abstract, figs. 2-3, 5-7, col.9, lines 10-22, 34-51; Mori, figs. 5, 7, 10AA, col.11, lines 25-34, col.13, lines 40-57).

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21. As per claim 32, the method corresponds directly to the image communication apparatus of claim 27, and thus is rejected under the same rationale.

22. Claims 28-29 and 33-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda, Praitis and Mori as applied to claims 27 and 32 above, and further in view of Iwazaki, US 6,687,742.

23. As per claim 28, Toyoda, Praitis and Mori taught the invention substantially as claimed in claim 27. Toyoda, Praitis and Mori did not expressly teach the predetermined header fixed message comprises [X:mailer:] field. Mori suggested exploration of art and/or provided a reason to modify the image receiving apparatus with other header fields (fig.7, col.7, lines 50-62, col.11, lines 25-34, col.19, lines 30-35). Iwazaki taught a predetermined header fixed message to comprise [X:mailer:] field (fig.5, col.6, lines 28-38, col.7, lines 27-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined apparatus of Toyoda, Praitis, and Mori to include the [X:mailer:] field in header parsing feature since it would be preferable to include all identification data needed to determine the status of incoming mail. Most users preferred to implement header parsing based upon additional list categories, such as the "TO", "FROM", "MESSAGE-ID", "CONTENT-TYPE" e-mail headers as well as other headers (Mori, col.7, lines 57-62, col.13, lines 40-57).

24. As per claim 29, Toyoda, Praitis and Mori taught the invention substantially as claimed in claim 27. Toyoda, Praitis and Mori did not expressly teach the predetermined image data fixed

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code comprises SUqk. Iwazaki taught the predetermined image data fixed code to comprises SUqk (fig.9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined apparatus of Toyoda, Praitis, and Mori to include the SUqk fixed code as a type of encoding method to encode the image message.

25. As per claims 33-34, the method corresponds directly to the image receiving apparatus of claims 29-29, and thus are rejected under the same rationale.

#### *Response to Arguments*

26. Applicant's arguments filed 8/31/2005 have been fully considered but they are not persuasive.

27. In the remark, applicant argued that (1) Toyoda does not disclose a header of a received e-mail which includes a predetermined character string. (2) RFC 2305 does not disclose judging whether or not the received e-mail is an error mail. (3) Toyoda, Praitis or Mori do not contain any disclosure regarding a controller which searches for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure. Toyoda, Praitis or Mori do not teach a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected. (4) Iwazaki is not available as a reference against the pending claims since the present application has an effective filing data of November

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11, 1999. Applicant declines to file a certified translation of the priority document. (5) The combination of references lacking proper motivation.

28. Examiner traverse the arguments:

As to points (1) and (2), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Toyoda taught to judge whether or not the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus based on a header of the received e-mail (col.6, lines 38-46, lines 57-61, col.7, lines 52-63). Toyoda provided a motivation to modify the image apparatus with the predetermined character string being related to a sender of the error mail (col.6, lines 57-61, col.7, lines 52-63). RFC 2305 disclosed teachings of judging the received e-mail based on whether or not a header of the e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail (Sections 2.2.1, 5.1, 5.2.1, 5.2.2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image receiving apparatus of Toyoda with the teachings of RFC 2305 to include the sender judging feature in order to maintain interoperability with Internet mail (Section 5.1) since any security to be provide should be part of the Internet security infrastructure (Section 5.1). In addition, parsing the sender to determine the mail status would also help save resources since unnecessary processing or error or failure mails consume

resources and therefore undesirable (Section 5.2.2 paragraphs 1-2). Toyoda and RFC 2305, in combination, teach the claimed limitations.

As to point (3), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Toyoda taught a controller configured to convert the attached data to image data (col.1, lines 42-61); and the controller further being configured to search for a predetermined information, and to judge that the received e-mail is an error mail being related to an e-mail transmitted by the image receiving apparatus, the error mail being related to an e-mail transmitted by the image receiving apparatus, when the predetermined information is detected (col.6, lines 38-46, 57-61, col.7, lines 52-63). Toyoda did not expressly teach for a predetermined image data fixed code in the image data part of the e-mail of the body of e-mail and to judge that the received e-mail is an error mail when the predetermined image data fixed code is detected. Praitis taught a controller for searching a predetermined data code in the data part of the electronic message and to judge that the received message is an error message, the electronic message being related to a message request transmitted by the receiving apparatus, when the predetermined data code is detected (abstract, figs. 2-3, 5-7, col.9, lines 10-22, 34-51; body of the page). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Toyoda with the teachings of Praitis to include the searching of data code in an electronic message structure in order to provide a more efficient method of identify the related error since the server

often create a returned message response having error information in the header and in the body of the message (Praitis, col.9, lines 18-22). Toyoda and Praitis did not expressly teach a multi/part structure electronic message having a predetermined data fixed code. Mori taught a network facsimile apparatus having a receiver configured to receive e-mails and a controller for searching a predetermined image data fixed code [boundary code] in the image data part of the e-mail when the receiving e-mail is a multi-part structure (figs. 5, 7 10AA, col.11, lines 25-34, col.13, lines 40-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined apparatus of Toyoda and Praitis with the teachings of Mori to include the searching of image data fixed code in a multi-part mail structure in order to provide a more accurate method of identifying error mail since header information are trivial to fake or unavailable and image data fixed code is often present in multi-part mail structure (Mori, figs. 5, 7). Toyoda, Praitis and Mori, in combination, teach the claimed limitations.

As to point (4), as stated in previous office action and also in paragraphs 3-4, the effective filing date for the subject matter defined in the pending claims which has support in parent JP 11-321411 in this application is 11/11/1999. Any new subject matter defined in the claims not previously disclosed in parent JP 11-321411, is entitled to the effective filing date of 07/18/2000. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Since the applicant declines to provide

translation of the foreign priority paper as evidence in proving support of subject matter claimed in foreign application, the subject matter claimed in this application is only entitled to the effective filing date of 7/18/2000 until proven. Therefore, Iwazaki is a valid reference.

As to point (5), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivations from the references were provided by the examiner and can also be found in the references, further, some motivations are knowledge generally available to one of ordinary skill in the art.

### ***Conclusion***

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

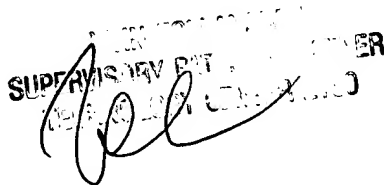
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ksl

November 23, 2005